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In re application of

Takuji Okamoto et al.

Serial No. 10/088,505

Filed: March 28, 2002

For: PROPYLENE POLYMER, AND RESIN COMPOSITION AND MOLDED PRODUCT
THEREOF

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO REVIEW THE RESTRICTION
REQUIREMENT of the office action mailed January 30, 2004.

On July 24, 2003, a non-final office action was mailed to applicants rejecting all of the pending claims. Applicants filed a response on November 24, 2003. On January 30, 2004, a lack of unity requirement was made in a non-final office action. In this requirement, the examiner held that the claims lack unity under PCT Rules 13.1 – 13.4. Three groups were presented by the examiner. Group I was directed to a propylene copolymer; Group II was directed to a propylene homopolymer; and Group III was directed to a catalyst composition. Applicants traversed the restriction requirement in a response filed on February 25, 2004 and requested reconsideration of the requirement. The examiner maintained the requirement in an office action mailed on April 16, 2004.

The instant petition was timely filed on June 16, 2004.

DECISION

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/JP00/06943 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B. The petitioner's request asserts that, since applicants received a first office action on the merits examining all of the claims, there is no undue burden of search present. Additionally, it is urged that because there was no holding of lack of unity in the International Application, there can be no holding in the instant National Phase application.

These arguments are not persuasive. Under the unity requirements, there is no provision for burden of search. While a burden of search is required to be shown for proper restriction under 35 USC 121, such is not the case for lack of unity guidelines. With respect to the argument that there was no holding of a lack of unity in the International Application, this does not preclude such a holding in the National Phase Application. Merely because the examiner handling the PCT Application chose not hold a lack of unity, such a decision does not necessarily mean a lack of unity does not exist.

Turning to the Lack of Unity requirement, the examiner maintains that the groups do not relate to a single general concept under PCT Rule 13.1, because they lack the same or corresponding special technical feature. It is argued that the copolymers of groups I and II are different types of polymers with different repeating units, therefore they do not share a common technical feature. It is further argued that the polymers do not share a common technical feature with the catalysts of group III.

The examiner's characterization of the relationship between the groups is improper. In the instant case, both groups of polymers are made using the instantly claimed catalysts. The catalysts link the groups together to form a common technical feature (i.e. the catalysts (Group III) are used to produce the polymers (Groups I and II)). Therefore, the lack of unity holding is improper.

Accordingly, the petition is **GRANTED**. The application is being forwarded to the examiner to withdraw the restriction requirement, examine all of the pending claims, and prepare a new non-final office action on the merits for all of the claims.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314